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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/403,796 10/25/99 SHAH

M

EXAMINER

QM12/0328

EDWIN D SCHINDLER
PO BOX 966
CORAM NY 11727-0966

GOODMAN, C	PAPER NUMBER
ART UNIT	

3724
DATE MAILED:

03/28/01

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/403,796	Applicant(s) SHAH, MUMTAZ	
	Examiner Charles Goodman	Art Unit 3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 January 2001.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

DETAILED ACTION

1. The amendment filed on January 11, 2001 has been entered.

Claim Rejections - 35 USC § 102

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 20-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Chuang.

Chuang discloses a plastic film cutter comprising all the elements claimed including, *inter alia*, a freely movable unit (e.g. 308 in Figs. 3A-B, the unit being freely movable along the guide rail 307); a lower part 323, 324, 325, 326 defining a sheet support surface (e.g. near 324 in Fig. 3C); an upper part 308; a gap (not designated by reference but see Figs. 3C-3D); a cutting blade 319, 320; pressure means 309-312; and a holder 329. See whole patent.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chuang in view of Shah (GB 2,223,976).

Chuang discloses the invention substantially as claimed except for matching sinusoidal surfaces on the upper and lower parts. However, Shah teaches a cutting device comprising upper and lower parts 3, 2 having matching sinusoidal surfaces (Fig. 6) which enhances tensioning of sheet material 1 to be cut. See Fig. 6, p. 4, ll. 6-15.

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Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of Chuang with the sinusoidal matching surfaces as taught by Shah in order to facilitate enhanced tensioning of the sheet material to be cut.

6. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chuang in view of Li.

Chuang discloses the invention substantially as claimed except for a window. However, Li teaches a window (the cut out portion above 24 in Fig. 1) which inherently serves as a means to visually observe the cutting action or the line of cut. See Fig. 1. Thus, it would have been obvious to the ordinary artisan at the time of the instant invention to provide the device of Chuang with the window as taught by Li in order to facilitate proper alignment and cutting of the sheet material.

7. Claims 20-22 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Li in view of Campbell Jr..

Li discloses the invention substantially as claimed including upper and lower parts 1, 2, a gap therebetween (not designated by reference but see Fig. 1), a cutting blade 23, and a blade holder 22. See whole patent. However, Li lacks a pressure means. In that regard, Campbell Jr. teaches a cutter having a pressure means or roller 17 disposed immediately in front of a cutting blade 14 for the purpose of placing the sheet material to be cut under tension. See Figs. 2-5, c. 3, ll. 5-37. Thus, it would have been obvious to the ordinary artisan at the time of the instant invention to provide the device of Li with the pressure means as taught by Campbell Jr. in order to facilitate enhanced tensioning of the sheet material during cutting.

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8. Claims 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Li in view of Campbell Jr. as applied to claims 20-22 and 24 above, and further in view of Shah (GB 2,223,976).

The modified device of Li discloses the invention substantially as claimed including substantially matching faces that facilitate sinusoidal shaping of the material to be cut and thereby provide tension. See Figs. 1-6. However, the faces themselves are not sinusoidal. In that regard, Shah teaches that sinusoidal matching faces is a well known face shape in the art. More specifically, Shah teaches a cutting device comprising upper and lower parts 3, 2 having matching sinusoidal faces (Fig. 6) which enhances tensioning of sheet material 1 to be cut. See Fig. 6, p. 4, ll. 6-15. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of Li with the sinusoidal matching faces as taught by Shah in order to facilitate tensioning of the sheet material to be cut or to substitute the sinusoidal faces of Shah for the non-sinusoidal faces of Li, modified, since either shapes are deemed to be equivalent means of tensioning and to substitute one for the other would have been an obvious matter of design choice, and since such a modification would have involved a mere change in the shape of a component. A change in shape is generally recognized as being within the level of ordinary skill in the art, especially since such a change does not render unexpected or unobvious results. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Response to Arguments

9. Applicant's arguments with respect to claims 20-24 have been considered but are moot in view of the new ground(s) of rejection.

However, some comments are deemed necessary.

In response to Applicant's basic argument that Chuang does not anticipate the claimed invention because Chuang lacks a "freely movable unit",¹ this argument is traversed. Applicant's contention that Chuang lacks this feature because the "unit" slides along a rail is not persuasive. The claim does not set forth exactly in which manner the "unit" must be "freely movable". As the Examiner points out in the rejection *supra*, the movable unit in Chuang is freely movable along the rail, and there is nothing in the claims that does not support this interpretation. Applicant is reminded that even though Chuang's "unit" may not be freely movable as the unit *disclosed* in the application, this feature is not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

37 In response to Applicant's basic argument that Li in view of Campbell Jr. does not render the claimed invention obvious because Li's invention is used to cut "wrappage" and cuts in a different manner than Applicant's invention,² this argument lacks merit. Appellant basically couches the argument against Li in the fact that Li cuts wrappage and that Li's intent is to cut the wrappage parallel to an edge of a roll of wrappage. However, this contention lacks any patentable weight since there is no patentable distinction between the "wrappage" in Li and the claimed "sheet material". Applicant's attention is directed to the first paragraph of Li which explains the scope of what Li considers as "wrappage". See Li, c. 1, ll. 4-20. Li teaches that "wrappage" is

¹ See Amendment B, Paper No. 7, p. 7, l. 8 - p. 8, l. 14.

² *Id.*, p. 8, l. 15 - p. 11, l. 10.

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“paper”, “sheet”, or “sheets” which clearly shows that Li anticipates this limitation in the claims. On the other hand, the claimed “sheet material” also lacks any patentable weight in that this recitation in the claims is related to the work. In that regard, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). Applicant also argues that the present invention is constructed to permit non-linear cutting of sheet material and thereby contending that Li does not anticipate the claimed invention.³ This argument is not clearly understood in that Applicant fails to set forth the patentable distinction between the prior art and the claimed invention. Claim 20 does not set forth any structure that states that the claimed invention must only cut in a non-linear manner. Moreover, Applicant cannot since the disclosed invention can perform both linear and non-linear cuttings. The same applies to Li in this regard. While Li *intends* to employ Li’s invention for the “parallel cutting”, there is nothing in Li that explicitly or implicitly teaches away from non-linear cutting. For example, there is nothing in claim 1 of Li that specifically prohibits Li’s claimed invention from performing non-linear cuts.

In response to Applicant’s basic argument that Campbell Jr., in combination with Li, does not render the claimed invention obvious,⁴ this argument lacks merit. First, Applicant’s contention that Campbell Jr. has little in common with the present

³ *Id.*, p. 9, l. 16 - p. 10, l. 1.

⁴ *Id.*, p. 10, l. 6 - p. 11, l. 3.

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invention (as opposed to the claimed invention) is far off the mark.⁵ It is irrelevant to what degree Campbell Jr. has with respect to Applicant's disclosed invention, since it is the claims that are at issue, not the disclosed invention. Moreover, there is nothing in the claims that distinguishes between what is considered to fall under the scope of Applicant's claimed "apparatus for cutting sheet material" and the letter opener of Campbell Jr. Applicant cannot argue that Campbell Jr. is not analogous to Li or to Applicant's own invention when all three are apparatus for cutting sheet material. In sum, there is no distinction, especially a patentable one. Second, Applicant attempts to show distinction in the way the guide wheels in Campbell Jr. are used.⁶ However, again, there is none. It is acknowledged that the guide wheels in Campbell Jr. bear "sideways" (or horizontally) but that does not detract from the fact that the guide wheel is located in front of the blade 14 and that the wheel also bears against the major surface of the work to be cut. In other words, the wheel is located in the same manner as Applicant's own invention. Fig. 2 of the disclosure shows wheel 22 in front of the cutting blade 14 which for purposes of discussion means that that they are arranged on the same plane perpendicular to the sheet material 23. In that regard, Campbell Jr. also shows the same arrangement in that both the wheel 17 and the blade 14 are arranged on the same plane perpendicular to the plane of the sheet material 7. Figs. 1-2 of Campbell Jr. Thus, contrary to Applicant's assertions, Campbell Jr.'s pressure exerting means are in no way substantially different than from Applicant's invention much less the

⁵ *Id.*, p. 10, ll. 6-12.

⁶ *Id.*, p. 10, ll. 13-19.

Applicant's claimed invention. There is nothing in the claims that require any specific orientation of the pressure exerting means.

Conclusion

10. Campbell et al, Yetman, Oginaezawa, Hirano, Nguyen, Stanbery et al, Eberhardt, Singh et al, Smithline, Zanfini, Bolduc, Busse, and Castelli are cited as additional pertinent art.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Goodman whose telephone number is (703) 308-0501. The examiner can normally be reached on Monday-Thursday between 7:30 AM to 6:00 PM EST.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada, can be reached on (703) 308-2187. The fax phone number for this Group is (703) 305-3579.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [rinaldi.rada@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1148.

cg 
March 24, 2001


Charles Goodman
Patent Examiner
AU 3724